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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:
 Kui Zhang et al.

Serial No.: 09/345,193

Filed: June 30, 1999

For: METHOD AND APPARATUS
 FOR MEASURING LATENCY
 OF A COMPUTER NETWORK

Examiner: Jain, Raj K

Art Unit: 2664

Cesari and McKenna, LLP
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 April 27, 2004

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Office of the Deputy Commissioner for Patent Examination Policy
ATTN: Office of Patent Legal Administration
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION OF PETITION
TO CORRECT FILING DATE

Applicants hereby request reconsideration of the Decision mailed February 17, 2005, denying applicants' Petition to Correct Filing Date.

On April 28, 2004, Applicants filed a Petition to Correct the Filing Date of the above-identified patent application. In the Petition, Applicants noted that, although the application was accorded a filing date of June 30, 1999, the correct filing date should be July 1, 1999 (one day later). In particular, the written description corresponding to this

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application makes reference to certain pages and figures that, it turns out, were missing from the materials submitted on June 30, 1999. These missing pages and figures, which correspond to a second patent application, were, however, submitted the very next day, i.e., on July 1, 1999¹, and Applicants requested, through their Petition, that this application be accorded, as its filing date, the date on which these missing pages and figures were submitted to the Patent and Trademark Office ("PTO").

On February 17, 2005, the Director issued a decision dismissing the Petition. The Director ruled that the application papers filed on June 30, 1999 included 31 pages of written description and claims, and seven drawing sheets. The Director therefore concluded that these papers entitled the Applicants to a filing date pursuant to 37 C.F.R. §1.53. The Director then dismissed Applicants' Petition.

Applicants agree that the papers filed on June 30, 1999 entitle them to a filing date of June 30, 1999. However, that is not the issue being presented by the Petition. The issue presented by the Petition is what filing date is to be assigned when an application for patent makes reference to certain pages and figures that are missing from the submitted materials, but are subsequently submitted the very next day? As set forth herein, the Patent and Trademark Office's own procedures clearly provide that, under circumstances such as these, applicants are given the opportunity to elect between the initial filing date that was assigned by the PTO, or the subsequent date on which the missing or omitted pages and figures are actually submitted. By dismissing the instant Petition, the

¹ The Decision on Petition states that the second application was filed on July 30, 1999, when it was actually submitted on July 1, 1999. See Filing Receipt, attached as Exhibit C to Petition to Correct Filing Date.

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Director has, in effect, denied Applicants the opportunity to choose the later submission date as their filing date; a choice which the PTO, through its own, well-established procedures, routinely grants to other applicants under these circumstances.

More specifically, Section 601.01(d) of the Manual of Patent Examining Procedure ("MPEP") provides that, when an application is filed without all of the pages of the specification, then the Office of Initial Patent Examination (OIPE) issues a "Notice of Omitted Items". The Notice of Omitted Items indicates that the application papers so deposited have been accorded a filing date, but that some pages of the specification are missing. The applicant can then respond to the Notice either by accepting the application as filed, thereby keeping the assigned filing date, or by submitting the omitted pages, and receiving, as the application's new filing date, the date on which the missing pages are submitted. See MPEP §6.01.01(d), at p. 600-12. Similarly, if an application is filed without all of the figures, then section 601.01(g) of the MPEP provides that a "Notice of Omitted Items" will be issued. Again, the applicant can either proceed to examination with the application as it was originally filed (i.e., without the missing figures), thereby maintaining the originally assigned filing date, or submit the missing figures and accept the date of such submission as the application's new filing date.

This is precisely the situation that occurred in the present case. In particular, on June 30, 1999, applicants filed certain application papers that explicitly make reference to and incorporate by reference the pages and figures of a second application. More specifically, the application papers of June 30, 1999 state as follows:

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To the extent source and destination ports are used by entities 202 and 204, the port numbers are preferably selected in accordance with commonly owned and co-pending U.S. Patent Application Ser. No. [insert serial number] entitled A Protocol to Coordinate Network End Points to Measure Network Latency, which is hereby incorporated by reference in its entirety.

See Specification at page 14, lines 14-18, attached as Exhibit A to the Petition to Correct Filing Date. Later on, at p. 22, the application papers of June 30, 1999 again refer to the pages and figures of the second application as disclosing a preferred embodiment of an aspect of the invention, as follows:

In the preferred embodiment, the format of the test message corresponds to the Network Endpoint Control Protocol (NECP), as described in previously referenced and incorporated U.S. Patent Application Ser. No. [insert serial number].

See Specification at page 22, lines 3-6, attached as Exhibit B to the Petition to Correct Filing Date.²

As it turns out, however, the second application was not submitted to the PTO until July 1, 1999, i.e., one day later. In other words, the pages and figures that were explicitly referenced in the June 30, 1999 application papers were, in fact, missing. Because the June 30, 1999 application papers makes reference to pages and figures that were not submitted, a Notice of Omitted Items under MPEP Sections 601.01(d) and (g) should have been issued. And, Applicants should have been given the opportunity of either proceeding to examination with the application papers as filed on June 30, 1999, or promptly submitting the missing pages and figures and being assigned, as a new filing date, the date the missing pages and figures were submitted.

² Reliance on a commonly assigned copending application for the purpose of completing a disclosure is permitted by the MPEP. See MPEP §608.01(p).

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Although no Notice of Omitted Items was ever issued in this application, Applicants have dutifully followed the procedures established by the PTO for being accorded, as a filing date, the subsequent date on which the missing pages and figures were submitted. First, the missing pages and figures from the June 30, 1999 application papers were promptly submitted to the PTO. Specifically, these pages and figures were submitted on July 1, 1999, which is just one day after the submission of the June 30, 1999 application papers. Such a prompt submission of missing pages and figures, i.e., within one day of the original submission, clearly satisfies the two-month period that the PTO grants to Applicants under these situations. See MPEP §601.01(d) (stating that an applicant has two months from the mailing of a Notice of Omitted Items to submit the missing pages). Second, even though no Notice of Omitted Items was ever mailed, Applicants went ahead and petitioned to accept the date on which the missing pages and figures were submitted, i.e., July 1, 1999, as the filing date of the instant application.

In sum, Applicants respectfully submit that the issue is not whether Applicants are entitled to a filing date based upon the papers filed on June 30, 1999, but rather whether Applicants should be given the same choice provided to all other applicants when a submission refers to pages and figures that are missing. Because Applicants have fully complied with the procedures established by the PTO for accepting, as a filing date, the date on which the missing pages and figures were subsequently submitted, Applicants respectfully submit that it was error for the Director to dismiss their Petition to Correct Filing Date. Accordingly, Applicants hereby request that the dismissal be withdrawn and that the Petition be granted.

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No. 03-1237.

Respectfully submitted,



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